REMARKS

The present amendment is in response to the Office Action mailed December 11, 2001. Claims 1-4 and 17-22 are standing for examination. The Examiner has rejected claims 1-4, 17-20 and 22 under 35 U.S.C. 102(b) as being anticipated by Lynch et al. (5,438,423) hereinafter Lynch.

The Examiner has used the common technique of quoting applicant's claim language element by element as though the reference uses the same language. This technique always poses a serious difficulty for applicant, in that the elements of applicant's claims are not specifically pointed out in the reference by the Examiner, which should be done a proper rejection. This seems to be a common and misleading practice in the Office and should be discontinued. The reference teaches what the reference teaches, and should be presented exactly as such. An argument may then be fairly made as to whether (or not) the reference's teaching reads on applicant's claim invention.

The Examiner states that, regarding claim 1, Lynch discloses all of the limitations of applicant's claim, including a user input on a user interface for inserting a flag-set into the recorded media, the flag-set searchable and usable as indicia for beginning a playback session of recorded media at a desired point in the recording sequence, the playback ending at a desired point in the recording sequence, or for selecting a media portion of the recorded media for permanent storage.

Regarding the above, applicant must first point out to the Examiner that in the last Office Action dated August 27, 2001 in the above-referenced case, applicant argued that the primary reference relied upon by the Examiner failed to provide a system allowing a user to enter a flag-set into a data stream, as is specifically claimed in applicant's claim 1. Applicant further argued that in order

to accomplish pulling a portion from anywhere within a recording for playback or permanent storage there must be at least a first flag marking a beginning point and an ending flag marking an ending point, the first and second flag comprising a flag-set.

However, in the Examiner's Response to Arguments section in the instant Office Action the Examiner states that applicant's above arguments with respect to claims 1-4 and 17-22 were considered but are moot in view of the new reference of Lynch provided by the Examiner and relied upon for the above 102(b) rejections of the claims. Applicant must assume therefore that because the Examiner, in the instant Office Action, provides the new reference of Lynch and does not provide the references relied upon for the rejections in the previous Office Action, applicant's arguments in response to the previous Office Action were sufficient to overcome the prior art cited.

Applicant has carefully studied the art of Lynch presented by the Examiner, and the Examiner's statements, and herein presents further argument to more particularly point out the subject matter regarded as the invention, and to establish that the claims distinguish unarguably over the prior art. Applicant points out and argues the limitations in the base claims that the Examiner again appears to have misunderstood in his rejections and statements.

Upon review of Lynch it is clear to applicant that Lynch does not disclose all of the limitations of applicant's claim 1, and applicant respectfully traverses the Examiner's above interpretation of the art of Lynch regarding flag-sets as claimed in applicant's invention. Applicant's claim 1 specifically recites a user input on the user interface for inserting a flag-set into the recorded media, the flag-set searchable and usable as indicia for beginning a playback session of recorded media at a desired point in the recording sequence or for selecting a media portion of the recorded media for permanent storage.

Applicant argues that the user input 28 of the user interface described in the Examiner's referenced portion of Lynch (Figure, col. 2, line 44 to col. 3, line 38) is not capable of setting a flag-set as claimed in applicant's invention. Applicant's claimed invention teaches inserting a first flag marking a beginning point and a second flag marking an ending point, the first and second flag comprising a flag-set. Lynch does not teach setting a flag-set at all. Lynch teaches setting only a single flag as a starting flag, from where a user may start a replay or store from that marked position. A second flag, which would comprise a flag-set, is nowhere mentioned or suggested in the art of Lynch. Col. 2, lines 57-68 of Lynch clearly describes a user input commanding control circuitry which, utilizing an address generator, marks a single point in a video program. When the mark command is given by the user interface the current address for the dynamic buffer is stored in a mark register, the viewer may then return to the marked starting point in the video program, the dynamic buffer reading the video program using the marked address as a starting read address. Their clearly is no capability of setting a second flag at a desired point in the system of Lynch, and therefore no capability of setting a flag set having a first and second flag inserted at two different desired points in the data stream that defines a start and an end of a media portion of the recorded media and pulling the portion for replaying or permanent storage, as is claimed in applicant's invention.

Applicant believes claim 1 is patentable over the art of Lynch because Lynch clearly fails to teach or suggest inserting a flag set comprising at least a first and second flag for marking a beginning and ending point for playback or permanent storage. Claims 2-4 and 17 are patentable on their own merits or least as depended from a patentable claim.

The Examiner has rejected applicant's method claims 18-19 for the same reasons for applicant's claims 1-2 above. Applicant assumes the Examiner is referring to claim 18 (not 19) when further stating that Lynch discloses the

claimed invention wherein in step (c) the flag-set marks the beginning and end of a desired block of media. Claim 18 is applicant's method claim corresponding to patentable claim 1, and includes the limitations regarding flag-set indicia argued above on behalf of claim 1. Col. 3, lines 22-38 of Lynch discusses temporarily saving a portion of video transferred to a static buffer, or permanently storing a video portion on a VCR, but nowhere deals with setting and initiating selective playback or permanent storage of media wherein activating a flag-set indicia from a user interface on the perpetual recording device enables playback or storing of the flagged media. Therefore, applicant believes that claim 18 is also patentable over the art of Lynch. Claims 19, 20 and 22 are patentable on their own merits or at least as depended from a patentable claim.

The Examiner has rejected claim 21 under 35 U.S.C. 103(a) as being unpatentable over Lynch in view of Ichinose ('569). The Examiner states that Lynch discloses all the features of the instant invention except for providing as discussed in claim 18 above that in step (d) the indicia is a jogging wheel manually operated to search the flag-sets, and Ichinose teaches a jogging wheel for selecting an ending point, and it was an obvious combine the rotary knob of Ichinose into the system of Lynch in order to facilitate the process of searching the flag-sets.

Applicant has carefully reviewed the art of Ichinose and it is clear to applicant that Ichinose also does not deal with inserting flag-sets comprising at least a first and second flag marking a beginning and ending point in a video stream, the flag sets searchable and usable as indicia for beginning a playback session of recorded media or permanently storing a portion of recorded media, as claimed in applicant's invention. Applicant believes the above arguments presented by applicant on behalf of claims 1-4, 17-20 and 22 and the failure of Lynch in anticipating the claimed invention, renders the Examiner's above 103(a)

rejection of claim 21 moot, and claim 21 is clearly patentable over the prior art on its own merits or at least as depended from a patentable claim.

As all of the claims now standing for examination as argued have been shown to be patentable over the art of Sprague, the applicant respectfully requests the art of Sprague be withdrawn by the Examiner and that the present case be passed quickly to issue.

If there are any time extensions due beyond any extension requested and paid with this amendment, such extensions are hereby requested. If there are any fees due beyond any fees paid with the present amendment, such fees are authorized to be deducted from deposit account 50-0534.

Versions With Markings to Show Changes Made

There are no amendments made in the present Amendment.

Respectfully Submitted,
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